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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/813,465
Filing Date: March 29, 2004
Appellant(s): HENDRICKSON, DOYLE D.

Nicole A. Ressue
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12-22-05 appealing from the Office action mailed 4-26-05.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

JP 3-188887	Matsuda	8-1991
579,655	Saladee et al.	3-1897
5,301,432	Richardson et al.	4-1994
5,581,895	Jeffcoat	12-1996

3,839,788 Addis 10-1974

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 8-10, 14-16, 19-20 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP Patent No. 3-188887.

Referring to claims 1 and 19, the Japanese patent discloses a cutting system comprising, a frame member – at 4-6, a blade body member – at 1-3, which is responsive to the frame member – see for example figures 1-11, a blade element – at 7, connected to the blade body member which is held by the blade body member – see for example figures 2-4, wherein the blade element is entirely removable from the blade body member – see for example figure 1, and has a straight cutting edge – se the bottom of blade 7 in figures 1-3, and an end – see proximate 6 in figure 2, an acute angle end point presented at the end of the blade element – see for example at 8 in figures 1-4, a pivot element – at 22,23, connected to the frame member wherein the blade body member which permits the blade body member to pivot with respect to the frame member – see for example figures 1-4, and a blade retention cavity – in items 4-6 as seen in figures 1-4, on the frame member wherein the blade retention cavity is configured to shield at least a portion of

the cutting edge of the blade element when the blade body member is pivoted with respect to the frame member – see for example figures 1-4.

Referring to claims 2 and 20, the Japanese patent discloses the acute angle end point presented at the end of the blade element comprises a dual straight edge element – see for example figures 1-11.

Referring to claim 8, the Japanese patent discloses the blade retention cavity is adapted for insertion of a replaceable blade – see for example figures 1-4, and further comprising a retaining element – at 5,6, wherein the replaceable blade is adapted to be held against the blade body member – at 1-3, by the retaining element – see for example figures 1-4.

Referring to claim 9, the Japanese patent discloses the retaining element comprises a single retaining element – see for example at 5,6 in figures 1-4.

Referring to claim 10, the Japanese patent discloses the frame member has an external frame surface – see for example figures 1-4, wherein the blade body member has an external blade body surface – see for example figures 1-4, and wherein the external frame surface and the external blade body surface present aligned shapes – see for example figures 1-4, when the blade body member is pivoted with respect to the frame member so that at least a portion of the cutting edge of the blade element is shielded by the blade retention cavity – see for example figures 1-4.

Referring to claim 14, the Japanese patent discloses a cut material centering element – at 3,6,9, behind at least a portion of the cutting edge – see for example figures 1-4.

Referring to claim 15, the Japanese patent discloses the cut material centering element comprises a concave feature – see at 3,6,9 in figures 1-4.

Referring to claim 16, the Japanese patent discloses the blade body member – at 1-3, is tapered and wherein the cut material centering element comprises the tapered blade body member – at 3 as seen in figures 1-4.

Referring to claim 22, the Japanese patent discloses the cutting instrument has a blade back portion and a frame front portion – see figures 1-4, and wherein the step of pivoting the blade with respect to the frame member comprises the step of aligning at least a portion of the blade back portion and the frame front portion – see for example figures 1-4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent as applied to claims 1 or 19 above, and further in view of U.S. Patent No. 5,301,432 to Richardson et al.

Referring to claims 3 and 21, The Japanese patent does not disclose a retaining element that holds the blade element with respect to the blade body member and wherein the retaining element is positioned approximately equidistant between the pivot element and the acute angle end point. Richardson et al. discloses a retaining element – at 18, that holds the blade element with respect to the blade body member – at 16,44, and wherein the retaining element is

positioned approximately equidistant between the pivot element and the acute angle end point – see for example figures 1-10. Therefore it would have been obvious to one of ordinary skill in the art to take the device of the Japanese patent and add the retaining element of Richardson et al., so as to allow for the blade element to be securely held to the blade body member.

Claims 4-7 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent as applied to claims 1 and 19 above, and further in view of U.S. Patent No. 579,655 to Saladee et al.

Referring to claims 4, 23 and 26, the Japanese patent does not disclose a releasable pivot lock to which the blade body member is responsive and which detachably prevents the blade element from pivoting with respect to the frame member. Saladee et al. does disclose a releasable pivot lock – at B,C,H,G,I, to which the blade body member – at F, is responsive and which detachably prevents the blade element – at F', from pivoting with respect to the frame member – at A,D, – see for example figures 1-8 and page 1 lines 58-87. Therefore it would have been obvious to one of ordinary skill in the art to take the device of the Japanese patent and add the pivot lock of Saladee et al., so as to allow for the blade to be in an unexposed position when not deployed thus making the device safer to operate.

Referring to claim 5, the Japanese patent as modified by Saladee et al. further discloses the releasable pivot lock – at H,I, locks the blade element – at F', at three roughly orthogonal positions – see for example figure 5 of Saladee et al., where the blade element – at F', is orthogonal to the frame – at A,D, at multiple positions.

Referring to claims 6 and 24, the Japanese patent. as modified by Saladee et al. further discloses the blade element – at F' of Saladee et al., and the blade body – at F, are pivoting

elements, and wherein the releasable pivot lock – at B,C,H,I, comprises a locking mechanism – at B,C,H, to which the blade element is responsive, and a spring element – at I, which yiedably urges the locking mechanism – at B,C, against at least one of the pivoting elements – at F' – see for example figures 1-8 of Saladee et al.

Referring to claims 7 and 25, the Japanese patent as modified by Saladee et al. further discloses the blade element – at F' of Saladee et al., and the blade body – at F, are pivoting elements and wherein the releasable pivot lock – at B,C,H,G,I comprises, a pin – at G, to which the blade element is responsive, and a spring element – at I, which yieldably urges the pin against at least one of the pivoting elements – at F – see for example figures 1-8 of Saladee et al.

Claims 11-12, 17-18 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent as applied to claims 1 or 19 above, and further in view of U.S. Patent No. 3,839,788 to Addis.

Referring to claim 11, the Japanese patent does not disclose the frame member comprises a frame member having at least one finger hole. Addis does disclose the frame member – at 16-24, comprises a frame member having at least one finger hole – see for example figure 13. Therefore it would have been obvious to one of ordinary skill in the art to take the device of the Japanese patent and add the finger hole of Addis, so as to allow for the device to be securely held by the user during use.

Referring to claims 12 and 28, the Japanese patent as modified by Addis further discloses a frictional rotational restraint element – at 30a,30b,42, located on the frame – at 12-16, adjacent at least one finger hole – proximate 22,24, and substantially diametrically opposed to the thumb rest – at 48 – see for example figures 11-13 of Addis.

Referring to claims 17 and 29, the Japanese patent does not disclose a thumb rest to which the frame member is responsive and which in use acts to cause a force, which is substantially perpendicular to at least a portion of the blade element. Addis does disclose a thumb rest – at 18b or 48, to which the frame member – at 12-16, is responsive and which in use acts to cause a force, which is substantially perpendicular to at least a portion of the blade element – see for example figures 11-13. Further, the limitations of when in use the thumb rest acts to cause a force which is substantially perpendicular to at least a portion of the blade element is an intended use recitation and it is deemed that the Addis device is capable of performing the claimed intended use in that the pressure applied to the thumb rest by the hand of the user produces a force which can be in any direction with respect to the blade. Therefore it would have been obvious to one of ordinary skill in the art to take the device of the Japanese patent and add the thumb rest of Addis, so as to allow the user to have greater control of the blade element during operation of the device.

Referring to claim 18, the Japanese patent as modified by Addis further discloses the frame member – at 4-6 of the Japanese patent, presents a spatial relation with respect to a cutting surface – at 7,8 – see for example figures 1-4, and further comprising a substantially planar lifting edge – see at the outer portion of 4-6 and a substantially planer retention edge – see at the inner portion of items 4-6, each form an angle with respect to the cutting surface when the frame member is positioned in the spatial relation – see for example figures 1-4, and wherein the angle of the substantially planer lifting edge with respect to the cutting surface is less than 90 degrees – see for example figures 1-4, while the angle of the substantially planer retention edge with

respect to the cutting surface is about 90 degrees – see for example figures 1-4 of the Japanese patent.

Referring to claim 27, the Japanese patent further discloses the cutting instrument has a blade – at 7,8, and a blade body member – at 1-3, having a slit – at 9, adapted for insertion of a blade – at 7,8,, and retaining element 5-6. The Japanese patent does not disclose the steps of removing the blade from the blade body member, replacing the blade with a replacement blade, inserting the replacement blade in the slit in the blade body member and retaining the replacement blade in the blade body member. Addis does disclose the steps of removing the blade – at 28, from the blade body member – at 14a,42, replacing the blade with a replacement blade, inserting the replacement blade in the slit in the blade body member and retaining the replacement blade in the blade body member – see for example figures 11-14 and column 3 lines 40-45. Therefore it would have been obvious to one of ordinary skill in the art to take the device of the Japanese patent and add the steps of replacing the blade of Addis, so as to allow for the blade to be replaced when it is damaged or worn out through excessive use.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over the Japanese patent as applied to claim 1 above, and further in view of U.S. Patent No. 5,581,895 to Jeffcoat. The Japanese patent further discloses the cutting edge – at 7,8, comprising a lifting edge proximate 7, and a retention edge – at 8. The Japanese patent does not disclose the lifting edge and the retention edge form an edge concave feature with respect to each other. Jeffcoat does disclose the lifting edge – proximate 30, and the retention edge – at 26, form an edge concave feature with respect to each other – see for example figures 1-2. Therefore it would have been

obvious to one of ordinary skill in the art to take the device of the Japanese patent and add the cutting edge of Jeffcoat, so as to allow the blade to perform multiple tasks.

(10) Response to Argument

Regarding claims 1-2, 8-10 and 14-16, the Japanese reference JP 3-188887 does disclose the blade element – at 7, is entirely removable from the blade body member – at 1-3 as seen in figure 1 where the blade – at 7 is pivotable with respect to the blade body member – at 1-3, and is pivotably moved upward as seen in the dotted lines in figure 1 where it is entirely removed from the blade body member – at 1-3. Alternatively, the blade element – at 7 is not integral with the frame – at 4-6 and the blade body member – at 1-3 and therefore the blade can be separated/disassembled from the frame – at 4-6 and the blade body member and thus be entirely removable from the blade body member since the blade, frame and blade body member are not a single one-piece integral unit. Appellant's disclosure is not specific on how the blade in figure 5 is connected to the blade body member. Further as seen in appellant's figure 5, the removable blade has a thru hole which it is assumed is connected via the pin – at 12 to the blade body member – at 2. Therefore the blade in figure 5 is removable because it is separate from the body member and not integrally formed which is similar to how the blade – at 7 in the Japanese reference is removed from the blade body member – at 1-3 as seen in figure 1 of the Japanese reference.

Further, the Japanese reference discloses an acute angle end point as seen in figures 1-2 where the blade – at 7, has an angled end portion which meets the straight bottom portion and straight top portion of the blade – at 7, to form a point where the angled portion and the straight portion of the blade meet as seen – at the blade edge 8 in figure 2. Appellant argues that the end

point is an obtuse angled end point but the claims do not offer any reference from which the acute angle is formed and there are two end points at the uppermost portion and lowermost portion of the blade edge – at 8 forming respective points and if one of these points is obtuse the other must be acute and therefore it is deemed that the Japanese reference discloses the claimed invention.

Regarding claims 19-20 and 22, the Japanese reference JP 3-188887 does disclose the blade element – at 7, is entirely removable from the blade body member – at 1-3 as seen in figure 1 where the blade – at 7 is pivotable with respect to the blade body member – at 1-3, and is pivotably moved upward as seen in the dotted lines in figure 1 where it is entirely removed from the blade body member – at 1-3. Alternatively, the blade element – at 7 is not integral with the frame – at 4-6 and the blade body member – at 1-3 and therefore the blade can be separated/disassembled from the frame – at 4-6 and the blade body member and thus be entirely removable from the blade body member since the blade, frame and blade body member are not a single one-piece integral unit. Appellant's disclosure is not specific on how the blade in figure 5 is connected to the blade body member. Further as seen in appellant's figure 5, the removable blade has a thru hole which it is assumed is connected via the pin – at 12 to the blade body member – at 2. Therefore the blade in figure 5 is removable because it is separate from the body member and not integrally formed which is similar to how the blade – at 7 in the Japanese reference is removed from the blade body member – at 1-3 as seen in figure 1 of the Japanese reference.

Further, the Japanese reference discloses an acute angle end point as seen in figures 1-2 where the blade – at 7, has an angled end portion which meets the straight bottom portion and

straight top portion of the blade – at 7, to form a point where the angled portion and the straight portion of the blade meet as seen – at the blade edge 8 in figure 2. Appellant argues that the end point is an obtuse angled end point but the claims do not offer any reference from which the acute angle is formed and there are two end points at the uppermost portion and lowermost portion of the blade edge – at 8 forming respective points and if one of these points is obtuse the other must be acute and therefore it is deemed that the Japanese reference discloses the claimed invention. Further, the end points at either the top or bottom of the blade edge – at 8 are presented to a material as seen in figure 5 where the blade is presented to an envelope. The entire blade – at 7 including any points formed at the edge – at 8 are presented to the envelope.

Regarding claims 3 and 21, appellant relies upon the arguments with respect to independent claims 1 and 19 and does not include arguments on the combination of the Japanese reference and Richardson et al. reference US 5301432. Appellant argues which limitations in the independent claims 1 and 19 that the Richardson et al. reference does not disclose. However, the Richardson et al. reference is not being used to disclose the limitations of these independent claims as seen in section (9) above. Therefore, these arguments are moot since they have already been discussed with respect to claims 1 and 19 above.

Regarding claims 4-7 and 23-26, appellant relies upon the arguments with respect to independent claims 1 and 19 and does not include arguments on the combination of the Japanese reference and Saladee et al. reference US 579,655. Appellant argues which limitations in the independent claims 1 and 19 that the Saladee et al. reference does not disclose. However, the Saladee et al. reference is not being used to disclose the limitations of these independent claims

as seen in section (9) above. Therefore, these arguments are moot since they have already been discussed with respect to claims 1 and 19 above.

Regarding claims 11-12, 17-18 and 27-29, appellant relies upon the arguments with respect to independent claims 1 and 19 and does not include arguments on the combination of the Japanese reference and Addis reference US 3,839,788. Appellant argues which limitations in the independent claims 1 and 19 that the Addis reference does not disclose. However, the Addis reference is not being used to disclose the limitations of these independent claims as seen in section (9) above. Therefore, these arguments are moot since they have already been discussed with respect to claims 1 and 19 above.

Regarding claim 13, appellant relies upon the arguments with respect to independent claim 1 and does not include arguments on the combination of the Japanese reference and Jeffcoat reference US 5,581,895. Appellant argues which limitations in the independent claims 1 and 19 that the Jeffcoat reference does not disclose. However, the Jeffcoat reference is not being used to disclose the limitations of these independent claims as seen in section (9) above. Therefore, these arguments are moot since they have already been discussed with respect to claims 1 and 19 above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

David Parsley DP

Conferees:

Robert Swiatek RS

Peter Poon PMP

PETER M. POON
SUPERVISORY PATENT EXAMINER

2/14/06